REMARKS:

Claims 1-34 are currently pending in the application.

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,038,668 to Chipman *et al.* ("*Chipman*") in view of U.S. Patent No. 6,094,680 to Hokanson ("*Hokanson*") and in further view of U.S. Patent No. 6,081,840 to Zhao ("*Zhao*").

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-34 stand rejected under 35 U.S.C. § 103(a) over *Chipman* in view of *Hokanson* and in further view of *Zhao.*

The Applicant respectfully submits that *Chipman*, *Hokanson*, or *Zhao*, either individually or in combination, fails to disclose, teach, or suggest each and every element of Claims 1-34. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-34 under 35 U.S.C. § 103(a) over the proposed combination of *Chipman*, *Hokanson*, and *Zhao*, either individually or in combination.

The Proposed *Chipman-Hokanson-Zhao* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Claims

For example, with respect to independent Claim 1, this claim recites:

> A method for ***migrating product data within an electronic commerce system***, comprising:
> monitoring requests for product data by ***users of a global content directory***, the global content directory comprising:
> a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class; and
> one or more pointers associated with each product class, each pointer identifying a seller database in which product data enabling a product transaction is stored for products associated with the product class;

generating a request history for each of the users based on the monitoring of the requests for product data by the users;

identifying the location of a particular user;

determining, based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user, whether the product data requested by the particular user should be migrated from a seller database to a storage location that is closer to the identified location of the particular user than the seller database; and

if it is determined that the product data should be migrated, ***initiating the migration of the product data requested by the particular user from the seller database to the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database***. (Emphasis Added).

Independent Claims 17, 33, and 34 recite similar limitations. *Chipman*, *Hokanson*, or *Zhao* fails to disclose each and every limitation of independent Claims 1, 17, 33, and 34.

The Applicant respectfully submits that *Chipman* fails to disclose, teach, or suggest independent Claim 1 limitations regarding a method or software "***for migrating product data within an electronic commerce system***" and in particular *Chipman* fails to disclose, teach, or suggest independent Claim 1 limitations regarding "monitoring requests for product data by ***users of a global content directory***, the global content directory comprising." The Office Action points to various passages of *Chipman*, column 3, lines 55-60, column 4, lines 35-40, column 5, lines 24-30, and column 7, lines 30-45, as teaching this limitation. However, these passages fail to teach, suggest, or even hint at the limitation of "monitoring requests for product data by ***users of a global content directory***, the global content directory comprising". The passages of *Chipman* cited by the Office Action merely describe a portal through which a user may search catalogued information. However, the "***portal***" disclosed in *Chipman* merely provides "an entry way into the stored catalogs of information", ***and does not include or is not even related to the global content directory***, as recited in independent Claim 1. (Column 5, Lines 5-10).

In addition, *Chipman* contemplates multiple portals located in various places, wherein each portal may refer to an individual company. (Column 5, lines 10-11). *Chipman* fails to teach, suggest, or even hint that the portals are a global content directory.

Rather, the portals in *Chipman* merely provide access for a user to perform searches on the various catalogues within that particular portal. *Chipman* simply fails to teach, suggest, or even hint that the portals or the catalogues taught in *Chipman* are equivalent to the "***global content directory***", as recited in independent Claim 1. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Chipman* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Chipman*.

The Office Action Acknowledges that *Chipman* Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Chipman* fails to disclose the emphasized limitations noted above in independent Claim 1. Specifically, the Office Action acknowledges that *Chipman* fails to disclose the limitations of "***identifying the location of a particular user***," "***determining, based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user, whether the product data requested by the particular user should be migrated from a seller database to a storage location that is closer to the identified location of the particular user than the seller database***" and "if it is determined that the product data should be migrated, ***initiating the migration of the product data requested by the particular user from the seller database to the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database***." (17 November 2006 Final Office Action, Pages 8-9). However, the Office Action alleges that portions of *Hokanson* cure the acknowledged shortcomings in *Chipman*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Hokanson*.

The Office Action alleges that *Hokanson* teaches the limitation of "***identifying the location of a particular user***" in column 4, lines 30-54. However, this passage of *Hokanson* merely states that the Figure 1 is shown with a user who is located in Seattle or

the surrounding area. That is merely a statement of what is depicted in the example. Nowhere does this passage of *Hokanson* or any other passage of *Hokanson* teach, suggest, or even hint at determining the actual location of a particular user. Thus, *Hokanson* fails to teach or suggest the limitation of "***identifying the location of a particular user.***"

The Applicant further respectfully submits that *Hokanson* fails to teach or suggest the limitation of "***determining, based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user, whether the product data requested by the particular user should be migrated from a seller database to a storage location that is closer to the identified location of the particular user than the seller database.***" The Office Action cites column 2, lines 35-61 of *Hokanson* as teaching this limitation. However, column 2, lines 35-61 of *Hokanson* fails to teach or suggest the limitation of "***determining, based at least in part on the request history for the particular user and a relative size of an organization associated with the particular user, whether the product data requested by the particular user should be migrated from a seller database to a storage location that is closer to the identified location of the particular user than the seller database***", as recited in independent Claim 1. Column 2, lines 35-61 of *Hokanson* merely teaches that a network manager makes a cost versus availability evaluation and to determine whether to move a resource to a local site.

However, the specifics of how this decision is made is more fully explained in column 6, lines 30-45, which list a set of criteria upon which the cost versus availability evaluation is based. The listed factors include expected user traffic, number of connections to the public network and storage capacity for local storage of resources. However, nowhere does this passage or any other passage of *Hokanson* teach, suggest, or even hint at making a determination based on "***at least in part on the request history for the particular user and a relative size of an organization associated with the particular user***", as recited in independent Claim 1. In addition, *Hokanson*, merely teaches that once the data is stored or temporarily cached at the local node that the

network manager manages, no further determination is made about moving the data elsewhere.

The Applicant further respectfully submits that *Hokanson* fails to disclose, teach, or suggest independent Claim 1 limitations regarding "if it is determined that the product data should be migrated, ***initiating the migration of the product data requested by the particular user from the seller database to the storage location, determined for the particular user, that is closer to the identified location of the particular user than the seller database***". In fact, *Hokanson* fails to teach, suggest, or even hint at migrating data for a particular user based on the particular user's request. *Hokanson* merely teaches temporarily caching data by a local node manager of a network that monitors data requests usage at the node. In *Hokanson*, if the requested data is stored in a remote location and the manager determines that the demand is sufficiently high for the data; so that it would be cheaper to temporarily store the data locally that continuously fetching the data from a remote location, the manage may then temporarily cache the data locally at the network cite or node. However, *Hokanson* fails to teach, suggest, or hint that this data is being stored based on a specific user, that the storage location is determined specifically based on that specific user, that the storage location is closer to a specific user, or even identifying the location of a specific user. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Hokanson* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish independent Claim 1 from *Hokanson*.

The Office Action Further Acknowledges that *Chipman* Fails to Disclose Various Limitations Recited in Applicant's Claims

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Chipman* fails to disclose the emphasized limitations noted above in independent Claim 1. Specifically, the Office Action acknowledges that *Chipman* fails to disclose the limitation of "***generating a request history for each of the users based on the monitoring of the requests for product data by the users***". (17

November 2006 Final Office Action, Page 9). However, the Office Action alleges that cited portions of *Hokanson* and *Zhao* cure the acknowledged shortcomings in *Chipman*. The Applicant respectfully traverses the Examiner's assertions regarding the subject matter disclosed in *Hokanson* and *Zhao*.

The Office Action states that *Hokanson* teaches "monitor[ing] the user demand for resources and dynamically adjusts the resource offerings to better service the user's requests by relocating the requested resource information to a location physically closer to the user". (17 November 2006 Final Office Action, Page 10). The Office Action apparently equates this to the limitation of "***generating a request history for each of the users based on the monitoring of the requests for product data by the users***". The Applicant respectfully disagrees. *Hokanson* merely teaches monitoring demand for remote resources. In *Hokanson*, if the demand becomes high enough, the remote data is then temporarily caches locally. Nowhere does *Hokanson* teach tying the demand to individual users or generating a request history of a specific user. Rather, as taught by *Hokanson*, the manager would know that 10,000 users requested the data item D, but the manager would have no way of knowing, specifically which users made up the 10,000 users. In addition, as taught by *Hokanson*, the manager would have no way of knowing what user 123 had specifically requested during any specific time period. Thus, *Hokanson* fails to teach or suggest the limitation of "***generating a request history for each of the users based on the monitoring of the requests for product data by the users***".

The Office Action also points to *Zhao*, column 3, lines 5-18, and column 4, lines 45-60 as allegedly teaching the limitation of "***generating a request history for each of the users based on the monitoring of the requests for product data by the users***". However, these passages and any other passages in *Zhao* fail to disclose, teach, or suggest independent Claim 1 limitations regarding "***generating a request history for each of the users based on the monitoring of the requests for product data by the users***". Rather, *Zhao* merely teaches monitoring usage patterns. That is, the number of times data is accessed is monitored, *Zhao* does not know who specifically requested the data. In fact, Zhao merely discloses "***determining the number of times each data***

file collection has been used or accessed". (Column 3, lines 9-11). (Emphasis Added). Thus, *Zhao*, merely discloses only monitoring data usage patterns. *Zhao* fails to teach, suggest, or even hint at tracking individual user requests or generating a request history for a specific user.

Therefore, the Applicant respectfully submits that *Hokanson* and *Zhao*, either individually or in combination, fail to disclose, teach, or suggest independent Claim 1 limitations regarding "***generating a request history for each of the users based on the monitoring of the requests for product data by the users***".

The Applicant's Claims are Patentable over the Proposed *Chipman-Hokanson-Zhao* Combination

The Applicant respectfully submits that independent Claim 1 is considered patentably distinguishable over the proposed combination of *Chipman*, *Hokanson*, and *Zhao*. This being the case, independent Claims 17, 33, and 34 are also considered patentably distinguishable over the proposed combination of *Chipman*, *Hokanson*, and *Zhao*.

With respect to dependent Claims 2-16 and 18-32: Claims 2-16 depend from independent Claim 1 and Claims 18-32 depend from independent Claim 17. As mentioned above, each of independent Claims 1, 17, 33, and 34 are considered patentably distinguishable over *Chipman*, *Hokanson*, and *Zhao*. Thus, dependent Claims 2-16 and 18-32 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-34 are not rendered obvious by the proposed combination of *Chipman*, *Hokanson*, and *Zhao*. The Applicant further respectfully submits that Claims 1-34 are in condition for allowance. Thus, the Applicant respectfully request that the rejection of Claims 1-34 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-34 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings***. Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on Applicant's disclosure***. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991; *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

1/8/07
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